

ELECTRONIC FILING

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/575,589
Inventor : Fergus Francis Murray
I.A. Filing Date : 10/14/2004
Title : LABORATORY APPARATUS WITH TWO CABINETS
Art Unit : Unassigned
Examiner : Unassigned

Docket No.: : URQUH-73865
Customer No. : 24201

DECLARATION OF ANDREW SKINN
(Petition Under 37 CFR § 1.47(b))

I, ANDREW SKINN, hereby declare and state as follows:

1. I am currently Chairman of Ruskinn Technology Limited ("Ruskinn"), which is petitioning ("Petitioner") to have the U.S. Patent and Trademark Office accept the above-identified application for Letters Patent due to the refusal of an inventor, Fergus Francis Murray, to sign the application. I was previously employed as a consultant by Biotrace Ltd, the original applicant's for the invention, prior to the invention being assigned to Ruskinn. I was employed by Biotrace at the time of the invention and I have been employed by Ruskinn to date. Ruskinn was originally part of the Biotrace Group of companies but remained as a separate legal entity. Mr Murry worked for Ruskinn from 1994 to 2001. In February 2006, Ruskinn separated from Biotrace and this is the company that I am now the Chairman of.

PROPRIETARY INTEREST:

2. Mr. Fergus Francis Murray, the "Non-signing Inventor" of the above-identified patent application was an employee at Biotrace Limited, when the invention was made and prior to the invention being assigned to Ruskinn Technology Limited. Mr. Murry was employed to work on the project which is subject of the invention from 2001 to May 2005 and this is as confirmed by the attached letter from Lynda Owen of Biotrace Ltd marked Exhibit B.

3. I am the co-inventor of the above-identified application, and the subject matter claimed therein, was made by Non-signing Inventor Fergus Francis Murray under the supervision of Julia Foster at Biotrace Ltd while he was employed by Biotrace and as part of his duties as an employee of Biotrace.

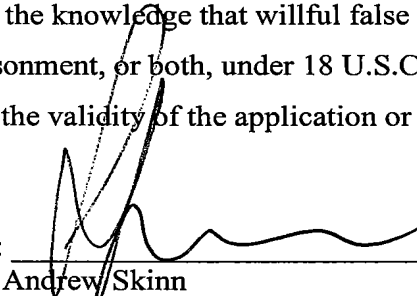
4. I am attaching as Exhibit C Section paragraphs 10.1.1, 10.1.3, 10.4 and 10.6 of Mr Murry's employment contract. In particular, Section 10.4.2 confirm that as an employee, ownership of invention will be determined in accordance with Section 39 of the Patents Act 1977. A copy of the relevant section of the Act is also attached as part of this Exhibit which confirm that an invention made by an employee shall be taken to belong to an employer if made in the course of the employees duties. The invention hence belonged to Biotrace and has now been assigned to Ruskinn.

IRREPARABLE HARM:

5. The invention that is the subject of the above-identified patent application is the subject of a development program that is underway at Ruskinn to commercialize the invention. Substantial funds have been expended and are being expended on this program. Failure to protect the invention by patent may permit competitors to make, use, and sell the invention and result in irreparable damage to that program and to Ruskinn.

6. The undersigned declares that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Dated: 8/05/07

Signed: 
Andrew Skinn
Ruskinn Technology Ltd

176118.1

"Exhibit B"

Fergus Murray
28 Low Ash Avenue
Wrose
Bradford
BD18 1 JJ

26th May 2005

Dear Fergus

Firstly, Biotrace Ltd. would like to take this opportunity to thank you for your commitment and loyalty to the Ruskinn product range since Ruskinn Technology Ltd. was acquired in 2001.

As you have reached the end of your notice period, we request that you sign and return a copy of this letter as confirmation that you have returned all Ruskinn Technology / Ruskinn Life Sciences and Biotrace Ltd. property to either the premises in Guiseley, West Yorkshire or passed to Lynda Owen and Andrew Bevan to be transported to the office in Bridgend, South Wales in compliance with 10.1.2 of your contract.

As you are no doubt aware, the contract of employment that you signed upon joining Biotrace Ltd. contains certain restrictions to employees both during and after their time with the company. I would like to draw your attention to 10.1.1, 10.1.3, 10.4 and 10.6 in particular, for your information, copies of these clauses are attached.

We would like to thank you once again and wish you the very best for your future.

Yours sincerely

Lynda Owen on behalf of Biotrace Ltd.

Signed

Fergus Murray

"Exhibit C"

10. Restrictions

10.1 Confidentiality

10.1.1 The Employee shall in all things keep the confidential information of the Company secret and shall not at any time hereafter (as well as during his/her employment hereunder) otherwise than in the proper course of his/her duties hereunder without the consent of the Company divulge or communicate to or cause or enable any person to become aware of such confidential information or other information of a confidential nature. Confidential information is defined in 10.2.3.

10.1.2 All notes, memoranda, financial and other documentation (by whatever medium kept or made) in relation to the Confidential Information, or to any trade secret or information concerning the business of the Company as shall be made or received by the Employee during the course of his/her employment hereunder shall be the property of the Company and shall be surrendered by the Employee to someone duly authorised in that behalf at the termination of his/her employment or at the request of the Company at any time during the course of his/her employment.

10.1.3 For the purposes of this contract Confidential Information shall include, but shall not be limited to information of a confidential nature relating to

10.1.3.1 The identity of customers, clients, distributors, agents and/or suppliers of the Company.

10.1.3.2 Customer lists, sales and marketing information, marketing methods and/or strategies, sales targets, sales forecasts, sales policies, market share statistics, marketing surveys and/or reports and/or marketing research of or relating to the Company.

10.1.3.3 Terms of trading, costings, prices and/or discount structures of or relating to the Company.

10.1.3.4 Commercial relationships and/or negotiations of the Company.

10.1.3.5 Financial information relating to the Company.

10.1.3.6 Research plans and/or projects, research results, new business opportunities, development plans and/or projects and/or business plans relating to the Company.

10.1.3.7 Formulae, designs, inventions, discoveries, know-how, specifications, drawings, data and/or flow charts all specific to the Company and its products.

10.1.3.8 Information specific to the design, manufacture, composition and/or use of any products and/or processes and/or any novel method of working of the Company.

10.1.3.9 Any of the products sold by the Company at the date of termination of this contract.

10.1.4 The obligations contained in clause 10.2 do not apply to any

Signed

Fergus Murray

information or knowledge which is already available to the public generally, otherwise than through the default of the Employee, or to any information required to be disclosed by law.

10.4 Inventions

10.4.1 If the Employee makes any invention, whether patentable or not, which relates to or is capable of being used in any business of the Company with which the Employee is employed at the time of making the invention, or has been (within the 2 years before that time) concerned to a material degree, the Employee must disclose it to the Company immediately.

10.4.2 As between the Employee and the Company, the ownership of all inventions made by the Employee will be determined in accordance with Section 39 of the Patents Act 1977.

10.5 Restrictive Covenants

In the following covenants, the Employee covenants on his or her own behalf or on behalf of any person, firm, company or organisation, for whom he/she is acting either directly or indirectly. Each of these covenants may only be varied with the prior written consent of the Board of the Company.

10.5.1 The Employee covenants with the Company that he or she will not, in competition with the business of the Company in which he or she was involved, solicit or assist in soliciting the custom or business or orders from any client or customer or distributor of the Company with whom the Employee has dealt during the last 12 months of employment. This applies for 6 months after the termination of the Employee's employment.

10.5.2 The Employee covenants with the Company that he or she will not endeavour to solicit or entice away from the Company any person who has at any time during the 12 months immediately preceding such termination of employment, been employed or engaged by the Company in the capacity of a director or senior manager or as an employee working in product development, sales or marketing. This applies for 6 months after the termination of the Employee's employment.

10.5.3 The Employee covenants with the Company that he or she will not at any time following the termination of the Employee's employment wrongfully interfere or seek wrongfully to interfere with the continuance of supplies to the Company by any supplier who has supplied services, goods or materials to the Company.

The restrictions set out in this clause 10.5 do not prohibit the Employee from carrying out any activities or from seeking or procuring of orders or the doing of business which are not in competition with any part or type of the business

Signed

Fergus Murray

of the Company with which the Employee was involved in the 12 months prior to termination of his or her employment.

The parties consider the covenants contained in this clause 10.5 reasonable. If any of the restrictions are held not to be valid on the basis that it exceeds what is reasonable for the protection of the interests of the Company but would be valid if part of the wording were deleted then such restrictions shall apply with such deletions as may be necessary to make it enforceable.

10.6 Additional restrictive covenant (if detailed in clause 1.17)

The Employee covenants with the Company that he or she will not, without the prior written consent of the Board of the Company, on his or her own behalf or on behalf of any person, firm, company or organisation, directly or indirectly for a period of six months after the termination of the Employee's employment with the Company be employed or engaged or otherwise interested in or concerned in any business or concern (or part thereof) which competes in the UK with the business of the Company in which the Employee was involved during the 12 months immediately preceding the termination of his or her employment.

Signed

Fergus Murray

PART I, SECTION 38]

is specified for the making of an application under these provisions. The terms "good faith" and "effective and serious preparations" also arise in sections 28A(4) and 64(1) and are discussed particularly in §§ 28A.04 and 64.05. For the possibility of this provision being contrary to Community law, see § 64.04.

Under subsection (5), the new proprietor or the person making the request can refer to the Comptroller the question of whether or not the request is justified, and the Comptroller can then decide the matter, including the terms of the licence, and may order the grant of a licence. If such a licence is ordered, it takes effect as a deed executed by all necessary parties, see section 108 and § 108.02.

If, as a result of a reference under section 8, 12 or 37, an employer-owned patent resulting from an employee's invention were transferred to a third party who is not a person connected with the employer, the employee's rights to compensation under section 40 would be confined thereafter to the benefit derived by the employer from the transfer, see § 41.04. However, it would seem that an order to transfer ownership would not be retroactive and thus such an employee could rely on any right to compensation which had accrued up to the date of the order for transfer.

38.05

PRACTICE UNDER SECTION 38

Any request under subsection (3) by an old proprietor or a licensee thereof must be made within the period prescribed by rule 57 (reprinted at § 38.02), that is within two months from the date of the order if made by an old proprietor and four months if made by a former licensee. These periods are, however, extensible at the Comptroller's discretion under rule 110(1), for which see § 123.36, but can also be shortened by the Comptroller "if he thinks fit, upon such notice to the parties and upon such terms as he may direct" (r. 110(2A), discussed in § 123.31). Since the request is to be made directly to the new proprietor, no form is specified for the request. Nor is it required that the Comptroller be notified of the request, though it may be prudent to do so, but the request would then become of public record on the file of the patent. Rule 57 is analogous to rule 9 (reprinted at § 8.04 and discussed in § 11.05).

Any reference to the Comptroller, either by the new proprietor or the person seeking a licence, is to be made on PF 2/77 (reprinted at § 140.02) under rule 58 (reprinted at § 38.03). This rule is analogous to rule 13 (reprinted at § 11.02) and the commentary thereon in § 11.06 is therefore applicable *mutatis mutandis*.

Employees' inventions [Sections 39–43]

39.01

SECTION 39

Right to employees' inventions

39.—(1) Notwithstanding anything in any rule of law, an invention made by an employee shall, as between him and his employer, be taken to belong to his employer for the purposes of this Act and all other purposes if—

- (a) it was made in the course of the normal duties of the employee or in the course of duties falling outside his normal duties, but specifically assigned to him, and the circumstances in either case were such that an invention might reasonably be expected to result from the carrying out of his duties; or
- (b) the invention was made in the course of the duties of the employee and, at the time of making the invention, because of the nature of his duties

[PART I, SECTION 39

and the particular responsibilities arising from the nature of his duties he had a special obligation to further the interests of the employer's undertaking.

(2) Any other invention made by an employee shall, as between him and his employer, be taken for those purposes to belong to the employee.

(3) Where by virtue of this section an invention belongs, as between him and his employer, to an employee, nothing done—

(a) by or on behalf of the employee or any person claiming under him for the purposes of pursuing an application for a patent, or

(b) by any person for the purpose of performing or working the invention,

shall be taken to infringe any copyright or design right to which, as between him and his employer, his employer is entitled in any model or document relating to the invention.

Note. Subsection (3) was inserted by Schedule 5, para. 11(1) [1988], with effect from January 7, 1991 (S.I. 1990 No. 2168).

COMMENTARY ON SECTION 39

General scope of provisions for "employees' inventions" (ss. 39–43)

39.02

Section 39 is the first of a group of sections (ss. 39–43) headed "Employees' Inventions". This group: defines a self-contained code for determining ownership of an "invention" (s. 39); regulates circumstances in which it would be "just" for an employer of such an "employee" to make payments, curiously termed "compensation", to that employee for the benefit which the employer has derived from a "patent" which has been granted for an "invention" made by the "employee" (s. 40); lays down guidelines for determining the quantum of such compensation (s. 41); renders unenforceable certain clauses in contracts of employment widely used before 1978 (s. 42); and limits the applicability of this group of sections to inventions made on or after June 1, 1978 and by persons "mainly employed" in the United Kingdom (including the Isle of Man). Some of the words in quotation marks in the preceding sentence are defined in section 43 (which is, in effect, a mini-interpretation section of ss. 39–42) and in section 130(1). These all receive discussion below and in the commentaries on the following sections 40–43.

There is a general discussion of this subject in the book by Chandler and Holland, *Information: Protection, Ownership and Rights* (Blackstone Press, 1992), and the provisions of sections 39–43 were summarised, from the point of view of industrial relations, in a paper by Susan Cox ((1991) 3(1) IPB 2).

Scope of section 39

39.03

Section 39 is a provision of substantive, rather than procedural, law. It has effect in relation to the settlement of entitlement disputes under section 8, 12, 37 or 82; and to the question of "compensation" under section 40. It relates to rights in inventions made after June 1, 1978 (s. 43(1)) by persons normally resident in the United Kingdom (s. 43(2)), and has effect in relation to "patents and other protection" generally irrespective of where or how granted, see section 43(4) and § 43.05. For the meaning of the term "invention" in this context, see § 39.04.

Put simply, the section specifies (in subs. (1)) the circumstances in which an invention made by such an employee will automatically, by operation of law, vest in the employer but, if none of the circumstances set out in subsection (1) exist, then under subsection (2)